

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/708,642
ATTORNEY DOCKET NO. Q61718

REMARKS

Applicant herein editorially amends claims 2-7, 10 and 11 to conform the claims to U.S. practice and to remove awkward language. The amendments to claims 2-7, 10 and 11 were made merely to more accurately claim the present invention, were not made for reasons of patentability, do not narrow the literal scope of the claims and do not implicate an estoppel in the application of the doctrine of equivalents.

Applicant herein amends claims 1, 8 and 9 to conform the claims to U.S. practice and to remove awkward language, and to clarify that the order of the symbols on the user interface dictates the flow sequence within the generated service function module.

The Patent Office objects to claims 5-7 as being dependent upon a rejected base claim. Applicant thanks the Patent Office for indicating that claims 5-7 would be allowed if rewritten in independent form. However, instead of rewriting claims 5-7 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Applicant herein adds new claims 12-17. New independent claim 12 includes recitations that have been indicated as allowable by the Patent Office in the October 4, 2004 Non-Final Office Action. No new matter has been added. Entry and consideration of the new claims 12-17 is respectfully requested.

Claims 1-17 are all the claims presently pending in the application.

1. Claims 6-9 and 11 stand objected to as containing informalities. Applicant respectfully traverses the objections to claims 6-9 and 11 for at least the reasons discussed below.

Applicant herein amends claim 6 to recite “Session Initiated Protocol” instead of the acronym “SIP”.

Applicant herein amends claim 6 to recite “Media Gateway Control Protocol” instead of the acronym “MGCP”.

Applicant herein amends claims 8 and 9 to remove the recitations of “designed to enable” and substitute therefor “that enables”.

Applicant herein amends claim 11 to recite that “computer program code” is run on a computer.

Applicant submits that the Patent Office’s objections to claims 6-9 and 11 have been overcome, and respectfully requests withdrawal of the objections to claims 6-9 and 11.

2. Claim 9 stands rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. Applicant herein amends claim 9 to remove the recitation of “the configuration server”. Applicant submits that the § 112 (2nd para.) rejection of claim 9 has been overcome, and respectfully requests withdrawal of the rejection of claim 9.

3. Claims 1-4 and 8-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sevcik (U.S. Patent No. 6,667,969) in view of Travis Russell, *Signaling System #7*, McGraw-Hill, 2nd ed., (1998), pgs. 20-23. Applicant traverses the rejection of claims 1-4 and 8-11 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In*

re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.*

Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.* Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d at 1316-1317 (*citing B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996)); *see also, Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

The combination of Sevcik and Russell fails to teach or suggest at least combining arranged procedure modules (depicted as symbols) into a service function module wherein the captured arrangement of the symbols dictates a flow sequence of the procedure modules in the generated service function module, as recited in claim 1. With respect to Sevcik, the Patent Office alleges that Figure 3 discloses combining the procedure modules into the service function module by inherency. The fact that a certain element *may* be present in the prior art is *not* sufficient to establish the inherency of that element. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*). For example, in Figures 3 of Sevcik, screening, routing and charging blocks are depicted, but there is no teaching or suggestion in the cited text (col. 3, lines 40-51, 60-67, col. 4, lines 13-20) that these functional blocks are generated by collecting individual procedure modules as recited in claim 1. The Patent Office appears to be assuming that that is how the functional blocks are

created, but without support from the text of Sevcik. Furthermore, there is no teaching or suggestion that the functional blocks of Sevcik are generated based on a captured arrangement of procedure modules that comprise a service function module, as recited in claim 1.

Moreover, when Sevcik is combined with Russell, the combination still fails to teach or suggest at least combining arranged procedure modules (depicted as symbols) into a service function module wherein the captured arrangement of the symbols dictates a flow sequence of the procedure modules in the generated service function module, as recited in claim 1. Russell discloses, *inter alia*, a service creation environment (SCE) that has a graphical user interface that uses icons to build customized services. However, like Sevcik, Russell lacks any teaching or suggestion that a captured arrangement of symbols dictates a flow sequence of procedure modules in the generated service function module, as recited in claim 1. At best, the combination of Sevcik and Russell discloses a system that displays iconic symbols of the services used for a particular network. In sum, there is no teaching of suggestion in the combination of the Sevcik and Russell of at least the creation of service function modules based on a captured arrangement of symbols dictates a flow sequence of procedure modules in the service function module. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicant submits that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is

improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Although the Patent Office provides a motivation analysis with respect to displaying procedure modules via a user interface, both Sevcik and Russell lack any teaching about the desirability of the creation of service function modules based on a captured arrangement of symbols dictates a flow sequence of procedure modules in the service function module. Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Sevcik and Russell fails to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2-4, 10 and 11 are allowable as well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 1-4, 10 and 11.

With respect to independent claims 8 and 9, Applicant submits that claims 8 and 9 are allowable for at least reasons analogous to those discussed above with respect to claim 1, in that the combination of Sevcik and Russell fails to teach or suggest at least the creation of service function modules based on a captured arrangement of symbols dictates a flow sequence of procedure modules in the service function module. Thus, Applicant submits that claims 8 and 9 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 8 and 9.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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USER INTERFACE
UI

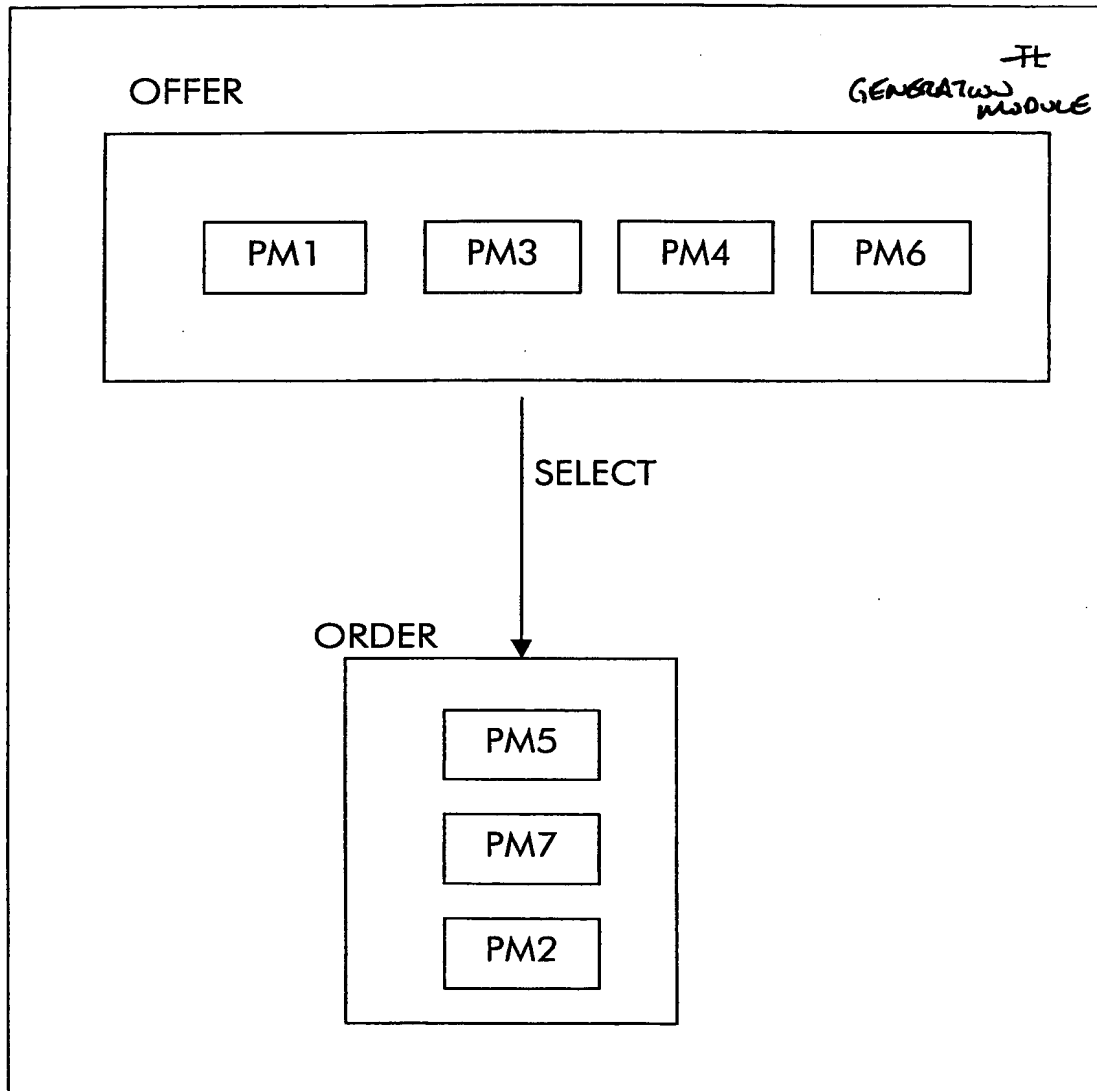


Fig. 1

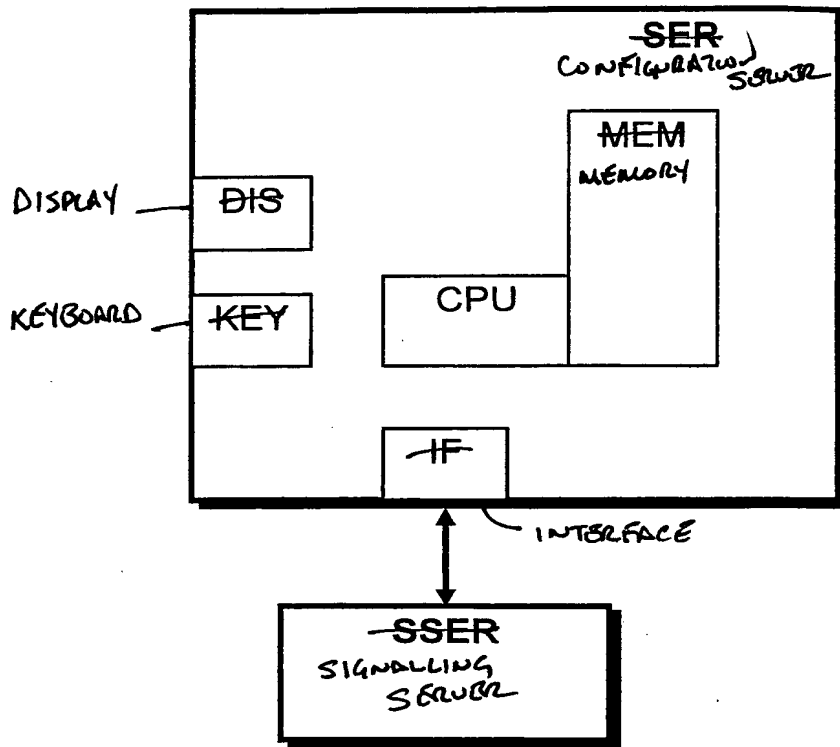


Fig. 2